

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

L0008/US

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on _____

Signature _____

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Application Number

10518985

Filed

December 31, 2004

First Named Inventor

MULDERMANS

Art Unit

1795

Examiner

WU

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Jason W. Bryan/

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Jason W. Bryan

Signature

Typed or printed name

☒ attorney or agent of record.
Registration number 51,505

713-571-3400

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

January 30, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application		Attorney Dkt No:	L0008/US
of:	Muldermans et al.	Confirmation No.:	3187
Serial No.:	10/518,985	Group Art Unit:	1795
Filed:	December 31, 2004	Examiner:	Wu, Ives J

Title: Photopolymerizable Compositions and Flexographic Printing Plates Derived Therefrom

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Applicants request review of the rejections made in the Office Action of September 30, 2008 for reasons set forth below. This request is being filed with a notice of appeal. The review is requested for the reasons stated on the attached sheets.

The undersigned representative authorizes the Commissioner to charge any additional fees under 37 C.F.R. 1.16 or 1.17 that may be required, or credit any overpayment, to Deposit Account No. 14-1437, referencing Attorney Docket No.: 8132.003.PCUS00.

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Respectfully submitted,

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January 30, 2009

REMARKS:

REGARDING THE CLAIMS:

Claims 12-14, and 17-30 are pending in the application.

IN RESPONSE TO THE OFFICE ACTION:

REJECTION UNDER 35 U.S.C. § 102:

Claims 11-14 and 17-30 stand rejected under 35 USC §103(a) as being unpatentable over Victor et al., US Pat. No. 6,127,094 (“**Victor**”). Applicants respectfully traverse this rejection.

The Examiner has maintained the rejection of the present claims that **Victor** discloses the block copolymer of the present claims. In particular the Examiner argues that **Victor** teaches a liquid isoprene and liquid butadiene meet the limitations of monomers for the block copolymer in component (E). The Examiner asserts that the elastomeric block copolymer of Victor includes the linkages of isoprene/butadiene, continues to read on Applicants’ formula A-C-A, and is therefore not different.

Applicants note the present claims recite a photopolymerization composition, “consisting essentially of” components (a)-(d), where component (a) includes a block copolymer A-C-A or (A-C)_nX (2). Applicants further respectfully submit that this transitional phrase is being ignored.

As noted in MPEP §2111.03, this transitional phrase “limits the scope of a claim to the specified materials or steps ‘and those that do not materially affect the basic and novel characteristics of the claimed invention.’” Therefore, if a cited reference includes a component which materially affects the basic and novel characteristics of a claimed invention, then the cited reference does not disclose or suggest that claim.

Applicants respectfully submit that even if **Victor** did disclose block copolymer A-C-A, the photosensitive resin composition of **Victor** requires additional components which would materially affect the basic and novel characteristics of the claimed invention. For example, the composition of **Victor** includes in part (A), Col. 3, lines 46-53:

(A) in the range of about 25 up to about 80 wt% of at least one copolymer consisting essentially of in the range of:

(i) about 25 up to about 95 mol % of at least one elastomer forming monomer,

(ii) about 0.5 up to about 30 mol % of at least one α,β -ethylenically saturated carboxylic acid, and

(iii) about 0.1 up to about 50 mol % of at least one polyfunctional vinyl monomer;

As the composition of Victor must include the above, and its inclusion would materially affect the claimed invention, Applicants respectfully assert that for at least this reason alone Victor falls outside the scope of the present claims. This is true even if Victor discloses a block copolymer of A-C-A. The reference requires additional components thereby falling outside the scope of the present claims. This is true due to the inclusion of the transitional phrase “consisting essentially of” in claims 11 and 24.

Additionally, “Elastomer forming monomers” as in (A)(i) according to Victor are defined in Col. 4, lines 36-44 of the reference as :

Elastomer forming monomers contemplated for use in the practice of the present invention include acrylates, methacrylates, and the like. Exemplary compounds contemplated for use herein include ethyl (meth)acrylate, methyl (meth)acrylate, hydroxyethyl (meth)acrylate, dimethylaminopropyl (meth)acrylate, diethylaminopropyl (meth)acrylate, 2-ethylhexyl (meth)acrylate, butyl (meth)acrylate, lauryl (meth)acrylate, and the like, as well as mixtures of any two or more thereof.

Furthermore, “ α,β -ethylenically saturated carboxylic acid” as in (A)(ii) according to Victor are defined in Col. 4, lines 45-50 as:

α,β -ethylenically unsaturated carboxylic acids contemplated for use in the practice of the present invention include methacrylic acid, acrylic acid, itaconic acid, maleic acid, β -carboxyethyl acrylate (.beta.-CEA), β -carboxyethyl methacrylate, and the like, as well as mixtures of any two or more thereof.

Additionally, “polyfunctional vinyl monomer” as in (A)(iii) according to Victor are defined in Col. 4, lines 51-59:

α,β -ethylenic site of unsaturation. Polyfunctional vinyl monomers contemplated for use in the practice of the present invention include

ethyleneglycol di(meth)acrylate (i.e., ethyleneglycol diacrylate or ethyleneglycol dimethacrylate), divinyl benzene, 1,6-hexanediol di(meth)acrylate, 1,4-butanediol di(meth)acrylate, trimethylolpropane tri(meth)acrylate, erythritol tetra(meth)acrylate, and the like.

As seen above **Victor** requires additional components A(i)-(A)(iii) which fall outside the scope of the present claims. Components A(ii) and (A)(iii) by themselves cause **Victor** to fall outside of the claims as well. Therefore, Applicants respectfully request the above mentioned rejection be withdrawn.

Additionally, the system of **Victor** is very polar, such that it will reach sufficient miscibility in water. This is because **Victor** is directed to water developable photosensitive printing plates and compositions useful in preparation thereof. *See Victor*, col. 1, lines 6-9. **Victor** sought to produce printing plates which would have good properties, yet allow for water processing, where material could be carried away by an aqueous media. *See Victor*, col. 3, lines 8-39. Accordingly, the additional components materially affect the basic and novel characteristics of the claimed invention. Therefore, the cited reference does not disclose or suggest the present claims.

Applicants further note that liquid isoprene and liquid butadiene are not encompassed by part (A) in **Victor**, but by component (E) in **Victor**. Additionally, Applicants assert that liquid isoprene and liquid butadiene are not the same as block copolymers having the formula A-C-A or (A-C)_nX. As indicated in **Victor**, these are linear polymers but not block copolymers. This can be seen by the fact that linear thermoplastic polymers are discussed regarding component (E) in **Victor**, Col. 3, lines 64 to Col. 4, line 5, with linear polymers mentioned in Col. 4, lines 6-8 of the reference. Linear liquid isoprene and liquid isoprene is mentioned as a linear polymer in col. 7, line 51 – and is encompassed by component (E) in **Victor**.

Additionally, in the advisory action of January 26, 2009, the Examiner further points out that liquid isoprene and liquid butadiene are recited in part (d) of Applicants claims 11 and 24. Applicants agree that claims 11 and 24 recite liquid poly(isoprene) and liquid poly(butadiene).

However, even though liquid poly(isoprene) and liquid(polybutadiene) are recited as auxiliaries in claims 11 and 24, this still does not change the fact that **Victor** requires

additional components, namely the components in part (A) of **Victor** which cause **Victor's** composition to fall outside the instant claims.

The Examiner on page 5 of the Office Action states that "Applicant is claiming a block copolymer or polymer in an elastomeric composition is not material to the composition." This is incorrect. Applicants claim includes elements (a) through (d). The composition of **Victor** requires additional components beyond that recited in the claims, namely those in part (A) including those of elements (a) through (d). The addition of these components of **Victor** would materially affect the currently claimed composition according to MPEP §2111.03.

The fact that part (d) of Applicants claims includes optional auxiliaries does not prevent Applicants from taking advantage of the transitional phrase "consisting essentially of." Applicants claimed invention may include these auxiliaries and not depart from the claimed invention. However, inclusion of **Victor's** component (A) is outside of the scope of parts (a) through (d) of the present claims as discussed above and their inclusion materially affects the basic and novel characteristics of the claimed invention. **Victor's** part (A) falls outside the scope of the present claims even including Applicants' claimed "auxiliaries." Accordingly, **Victor** does not disclose or suggest the claimed invention.

Applicants respectfully request the above mentioned rejection be withdrawn.